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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/297,519    05/03/99    MIDOUX    P    410.015

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HM22/0731

EXAMINER

NGUYEN, D

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

07/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

Application No.  
09/297,519

Applicant(s)

Midoux

Examiner

Dave Nguyen

Art Unit

1633



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 17, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☒ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The proposed claims while obviating outstanding rejection under 112, 1<sup>st</sup> a 103, raise new issues regarding 112 1<sup>st</sup> & 112 2<sup>nd</sup> paragraphs, and prior art rejections

4. ☐ Applicant's reply has overcome the following rejection(s):  
None since the proposed claims have not been entered. However, should applicant correct issues as indicated below, the proposed claims once corrected would overcome all outstanding rejections
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
the proposed newly added claims have numerous problems under 112 2<sup>nd</sup> paragraph, and couple issues regarding 112 1<sup>st</sup> paragraph; see attached sheets
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: 20-40
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 20-40

9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

11. ☒ Other: Note that the proposed claims if submitted again in correction, the abstract must also be include for entry, since any amendment after cannot be entered in-part.

DAVE NGUYEN  
PRIMARY EXAMINER  
ART UNIT 1633

Newly found issues from the proposed newly added claims that would raise further examination and consideration:

- In claim 45, the phrase "some of the free" is indefinite: a change to "at least one" would correct overcome the issue;
- In claim 45, the phrase "can be" should be changed to "is" for clarification.
- In claim 45, the phrase "said residue" should be changed to "said residues" to have proper antecedent basis.
- In claim 45, the use of the phrases of "or a disaccharide" and "or complex osides" are not proper Markush language for - selected from the group consisting of A, B, C, D, and E -, for example. In addition, the phrase "and oligolactosamines or peptides" is indefinite because it is not apparent as to how such phrase is a proper Markush group, nor is it apparent as to how "peptides" are members of complex osides.
- In claim 46, "A complex of claim 44" should be recited as "The complex of claim 44" to have proper dependent claim and clarification.
- In claim 46, it is not apparent as to how the recitation of "to the family of pterines" and/or "to the family of pyridine" are member of "said quinolines" since the claim is recited in a Markush language, nor is it apparent as to what are exactly the metes and bounds of the phrases, nor is it apparent as to how the claim is further limited from the base claim, since pterines, for example, is not the same as "said quinolines" which is defined as the formula in the base claim. Furthermore, by intending to claim such phrase, the claim would also raise issues under 112, first paragraph as to new matter and breadth of the claims.
- In claim 47, the phrase "a reduction i the" is indefinite. Clarification is requested.
- In claim 49, between the members of the recited Markush group, there is no -- , -- or - ; - to distinguish the alternative language for each of the individual members of the Markush group. Furthermore, for each specific member of asialoglycoprotein receptor following by a depicted diagram, the claim should be clarified by reciting, for example:

(a) Asialo-oligoside of the type of triantennar lactosamine: the asialoglycoprotein receptor of the formula:

- In claim 49, an article "and" should be typed immediately in front of the last member of the Markush group.
- IN claim 50, "SEQ ID NO" must be employed for amino acid sequence greater than 4 residues.
- In claim 50, the metes and bounds of the "peptides containing the RGC sequence" or "formyl peptides and their antagonists" are not clear as to its core structure. What is the "RGC" which do not appear to stand for amino acid residues? What is the "formyl"? Nor is it apparent as to what is exactly meant by "their antagonists". The claim would also raise issues under 35 U.S.C. 112, first paragraph for written description and scope of the claims.
- In claim 53, the recitation "it being possible" renders the claim indefinite.
- In claim 53, it is not apparent as to what is the linkage between the formula depicted at the bottom of page and one depicted in the beginning of page 9. Is it one formula or the markush group of two formulas?
- In claim 55, it is not apparent as to how "peptides" alone are members of complex osides.
- In claim 56, An article "The" should be typed at the beginning of the claim to make it proper dependent claim under US standard.
- In claim 56, "the said" should be typed simply as "said".
- In claim 58, "The" should be substituted for "A composition of claim 57"
- In claim 59, an article "and" should be typed immediately in front of the last member of the Markush group.

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Should applicant intend to file another supplemental amendment after final to reflect the correction of the listed issues, as indicated above, the amendment to the claims should be reviewed for thoroughness so as to prevent any newly found issues that may arise from the proposed claims.

Any inquiry concerning this communication or earlier communications regarding the formalities should be directed to Patent Analyst Kimberly Davis, whose telephone number is **(703) 305-3015**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **(703) 305-2024**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Deborah Clark*, may be reached at **(703) 305-4051**.

Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is **(703) 308-0196**.

Dave Nguyen  
Primary Examiner  
Art Unit: 1633

**DAVE T. NGUYEN  
PRIMARY EXAMINER**